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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,623

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Dennis R. Boulais

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,623	<b>Applicant(s)</b> BOULAIS, DENNIS R.	
	<b>Examiner</b> Matthew J. Kasztejna	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-9, 12, 14 and 16-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-4, 7-9, 12, 14 and 16-26 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/29/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on July 27, 2005, amended claims 1-4, 7-9, 12, 14, 16 and 18-20; cancelled claims 5-6, 10-11, 13 and 15; and new claims 21-26 are acknowledged. All current rejections under 35 USC § 102(a) and 35 USC § 103(a) are *withdrawn*. The objection to the drawings *stands*. The following new and reiterated grounds of rejection are set forth:

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the poor picture quality of Figure 1. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 7-9, 14-22 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2002/0133077 to Edwardsen et al.

**In regards to claims 1 and 14-18**, Edwardsen et al. disclose an operator control device for controlling an endoscope, the endoscope having an endoscope shaft, the operator control device comprising: one or more controls 214 for controlling the endoscope; a rotating component 226 for being coupled to a fixed feature 210 on the endoscope shaft the rotating component allowing a rotation of the operator control device with respect to the endoscope shaft (see Fig. 2 and paragraph 0030); a trigger component 810 for switching the operator control device between an engaged mode and a disengaged mode; and an anti-rotating component 830 for preventing the operator control device from rotating with respect to the endoscope shaft when the operator control device is in the engaged mode, the operator control device being allowed to rotate with respect to the endoscope shaft when the operator control device is in the disengaged mode (see paragraphs 0033-0036). The apparatus of Edwardsen et al. is considered to be inherently capable of performing the recited method claims.

**In regards to claims 3, 22 and 25**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the trigger component may be manually operated to switch between the engaged mode and the disengaged mode (see paragraph 0034). The apparatus of Edwardsen et al. is considered to be inherently capable of performing the recited method claim.

**In regards to claims 7 and 20**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the fixed feature on the endoscope shaft is a break-out box 210 (see Fig. 2).

**In regards to claims 8 and 19**, Edwardsen et al. disclose an operator control device for controlling an endoscope wherein the rotating component comprises a collar 226 (see Fig. 2).

**In regards to claim 9**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the collar is a rotating locking collar that is attached to the proximal end of the fixed feature on the endoscope shaft (see paragraph 0031-0032).

**In regards to claims 21 and 24**, Edwardsen et al. disclose an operator control device for controlling an endoscope, wherein the anti-rotating component comprises an anti-rotation pad 830 (see paragraph 0034).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0133077 to Edwardsen et al. in view of U.S. Patent No. 6,830,545 to Bendall.

**In regards to claim 2**, Edwardsen et al. disclose an operator control device for controlling an endoscope but are silent with respect to wherein the operator control device has a detachment mode which allows the operator control device to be detached from the endoscope shaft for cleaning and reuse. Bendall teaches of an analogous

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operator control device wherein having a detachment mode which allows the operator control device to be detached from the endoscope shaft for cleaning and reuse (see Col. 3, Lines 51-54). It would have been obvious to one skilled in the art at the time the invention was made to have a detachable operator control device in the apparatus of Edwardsen et al. in order to provide a device which can be easily sterilized as taught by Bendall.

**In regards to claims 4, 23 and 26**, Edwardsen et al. disclose an operator control device for controlling an endoscope but are silent with respect to wherein the trigger component may be remotely operated to switch between the engaged mode and the disengaged mode. Bendall teaches of an analogous operator control device wherein a rear portion 16 contains a small radio transceiver 26 with an antenna 27 for wireless communication to a probe base station 29, and thus allowing for remote control of desired operator components. It would have been obvious to one skilled in the art at the time the invention was made to include a wireless connection in the apparatus of Edwardsen et al. in order to provide wireless control of desired actuators as taught by Bendall. The apparatus of Edwardsen et al. and Bendall is considered to be inherently capable of performing the recited method claims.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0133077 to Edwardsen et al. in view of U.S. Patent No. 6,805,664 to Doyle et al.

**In regards to claim 12**, Edwardsen et al. disclose an operator control device with an engaging component but are silent with respect to wherein the rotating

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component being a clutch mechanism. Doyle et al. teach of an analogous apparatus having a clutch 202 for adjusting the position of a device (see Col. 4, Lines 23-67). It would have been obvious to one skilled in the art to use a clutch means in the apparatus of Bendall in order to provide a means for rotationally positioning an instrument for surgery as taught by Doyle et al.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 14 and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *ML*

10/05/05

  
BEVERLY M. FLANAGAN  
PRIMARY EXAMINER